

### REMARKS

This response is submitted in reply to the final Office Action dated September 28, 2007. Claims 1-21 are currently indicated as being rejected. However, Applicant previously canceled claims 13 and 14 and thus the rejections of claims 13 and 14 remain moot. With regard to the rejections of claims 1-12 and 15-21, Applicant respectfully traverses.

In light of the remarks presented below, Applicant respectfully requests reconsideration and allowance of all now-pending claims of the present application.

#### *Claim Rejections - 35 USC §103*

Claims 1-10, 15 and 16 currently stand rejected under 35 U.S.C. §103(a) as being unpatentable over Baker et al. (U.S. Patent No. 6,507,735, hereinafter “Baker”) in view of Akahane (U.S. Patent No. 5,881,104). Claims 10 and 19 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Baker in view of Ayoub et al. (International Patent Application No. WO 99/41922, referred to in the Office Action as “Souhad” and hereinafter “Ayoub”) and further in view of Parvulescu et al. (U.S. Patent No. 5,724,410, hereinafter “Parvulescu”). Claims 11, 12, 17 and 18 stand rejected under 35 U.S.C. §103(a) as being unpatentable over the combination of Baker, Ayoub and Parvulescu and further in view of Smith et al. (U.S. Patent No. 6,891,811, hereinafter “Smith”). Claim 20 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Ayoub and Parvulescu and claim 21 currently stands rejected under 35 U.S.C. §103(a) as being unpatentable over Akahane in view of Parvulescu. Applicant respectfully traverses.

#### Independent claims 1, 10 and 21

As an initial matter, Applicant respectfully notes that Baker, Akahane, Parvulescu and Smith are each related to conventional voice mail and not SVMS messages as recited in the claimed invention. Moreover, Applicant has previously defined that the SVMS message is defined as a message including packetized voice data configured to be deliverable to a plurality of recipients as a result of a single transmission from the originating station in each of independent claims 1, 10 and 19-21. Thus, particularly with respect the rejections of

independent claims 1 and 10 made over the combination of Baker and Akahane and the rejection of claim 21 made over the combination of Akahane and Parvulescu, Applicant respectfully notes that given the deficiency of Baker, Akahane and Parvulescu with regard to any disclosure of operations with respect to an SVMS message as defined in independent claims 1, 10 and 21, the combination of Baker, Akahane and Parvulescu fails to teach or suggest any of the recited operations with respect to an SVMS message which is defined as a message including packetized voice data configured to be deliverable to a plurality of recipients as a result of a single transmission from the originating station.

Of note, the final Office Action asserts that the above recited feature is disclosed in Akahane at col. 6, line 40 to col. 7, line 21. More specifically, the final Office Action asserts that “communication of a messages from a first station is not limited to only one recipient, therefore, communication of a messages to a plurality of recipient is inherent”. Applicant respectfully disagrees with this analysis. In this regard, in order to establish inherency, “extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.’” *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999).

In the present situation, it cannot be fairly asserted that if Akahane fails to state that the voice messages only go to one recipient, it necessarily means that the voice messages may be delivered to a plurality of recipients as a result of a single transmission from the originating station, as provided in the claimed invention. To the contrary, conventional voice messages are well known by those of skill in the art (and even lay persons) to be provided directly from one individual to another individual. As such, any assertion that a lack of mentioning that the voice messages of Akahane are limited to reception by only one recipient could, at best, be considered to leave open the possibility that the messages may be received by more than one recipient. However, as indicated above, inherency is not established based on possibilities.

Furthermore, as stated in MPEP 2112 citing *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990), “the Examiner must provide a basis in fact and/or technical reasoning

to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” In the present situation, not only is the recited feature not inherent in the disclosure of Akahane, but the Examiner has also failed to provide any basis in fact or technical reasoning to support such a determination as required by the MPEP citing the patent laws. Since Akahane, Baker, Parvulescu and Smith all individually fail to teach or suggest the above recited feature, any combination of these references also fails to teach or suggest the above recited feature. Furthermore, since none of Akahane, Baker, Parvulescu and Smith are related to SVMS messages, the recited operations performed with respect to SVMS messages are also neither taught nor suggested by Akahane, Baker, Parvulescu and Smith either alone or in combination. Accordingly, for the reasons indicated above, the rejections of independent claims 1, 10 and 21 are traversed.

Independent claims 10 and 19-21

Independent claims 10 and 19-21 also stand rejected in view of various combinations of Baker, Akahane, Parvulescu and Smith along with Ayoub. Ayoub is directed to a method for broadcast transmission of short voice messages. Thus, Ayoub is the only one of any of the currently cited references that arguably lies in the same field as the claimed invention. However, Ayoub does not perform each of the operations recited in the claimed invention with regard to SVMS messages and is also not cited as such. Thus, various ones of Akahane, Baker, Parvulescu and Smith are cited in connection with the various operations recited by the claimed invention. One particular such operation relates to determining whether the intended recipient is capable of receiving the SVMS message prior to transmission of the SVMS message. Such feature is recited in each of independent claims 10 and 19-21 and is neither taught nor suggested by the cited references, either alone or in combination.

Notably, the final Office Action admits, and Applicant agrees, that Ayoub fails to teach or suggest determining whether the intended recipient is capable of receiving the SVMS message prior to transmission of the SVMS message. Applicant further asserts that Baker, Akahane and Smith also fail to teach or suggest this feature and are not cited as such. In order to cure the deficiencies of the other cited references, the final Office Action cites Parvulescu as disclosing

the above recited feature in the abstract and at col. 2, lines 10-48. However, the cited passages of Parvulescu only relate to determining whether a receiving terminal is capable of reproducing a voice message. As such, Parvulescu does not relate to the ability of the receiving terminal to actually receive the message, but instead whether it can render the message (i.e., whether the receiving terminal has an audio reproducing unit 32 capable of reproducing the voice message). Thus, Parvulescu completely ignores any determination with regard to whether the receiving terminal can receive the message, but instead focuses on determining whether the receiving terminal has, for example, a speaker and other hardware or software to support playing a voice message. A determination with regard to whether a device can receive a message is clearly quite different from a determination as to whether a device can reproduce a message. In this regard, a message could clearly be capable of reception independent of whether the message is capable of reproduction. Accordingly, Parvulescu's determination with regard to whether the receiving terminal can reproduce a conventional voice message is unrelated to, and neither taught nor suggestive of, determining whether the intended recipient is capable of receiving the SVMS message prior to transmission of the SVMS message as recited in independent claims 10 and 19-21.

Since none of the cited references teach or suggest determining whether the intended recipient is capable of receiving the SVMS message prior to transmission of the SVMS message as recited in independent claims 10 and 19-21, any combination of the cited references also fails to teach or suggest the above recited features of independent claims 10 and 19-21. Independent claims 10 and 19-21 are therefore patentable over the cited references taken either alone or in combination. Accordingly, for the reasons indicated above, the rejections of independent claims 10 and 19-21 are traversed.

#### Dependent claims

Claims 2-9, 11, 12 and 15-18 depend either directly or indirectly from independent claims 1 and 10, respectively, and thus include all the recitations of their respective independent claims. Dependent claims 2-9, 11, 12 and 15-18 are therefore patentable over the cited

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references, either alone or in combination, for at least the same reasons given above with respect to independent claims 1 and 10.

Accordingly, for all the reasons stated above, the rejection of claims 1-12 and 15-21 are traversed.

**CONCLUSION**

In view of the remarks presented above, Applicant respectfully submits that all of the claims of the present application are in condition for allowance. It is respectfully requested that a Notice of Allowance be issued in due course. The Examiner is encouraged to contact Applicant's undersigned attorney to resolve any remaining issues in order to expedite examination of the present application.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

Respectfully submitted,



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